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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,559	09/22/2003	Hubert Kurzinger	12742.0005US11	9973
23552	7590	05/18/2006	EXAMINER	
MERCHANT & GOULD PC			SAYALA, CHHAYA D	
P.O. BOX 2903			ART UNIT	
MINNEAPOLIS, MN 55402-0903			PAPER NUMBER	

1761

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,559

Applicant(s)

KURZINGER ET AL.

Examiner

C. SAYALA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Reopening of Prosecution After Appeal

In view of the appeal brief filed on 3/13/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



Glenn Caidarola
Supervisory Patent Examiner
Technology Center 1700



MILTON I. CANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (US Patent 5936069).

At col. 7, lines 1-3, the patent shows a flake with 11% moisture and a thickness of 0.25 mm thickness. "For aquatic animals" is use terminology and intended use of an otherwise old or obvious composition cannot render a claim patentable. In re Zierden, 162 USPQ 102, In re Jones, 50 USPQ 48, In re Spada, 15 USPQ 2d, 1655, In re Thuau 57 USPQ 324. The specification states that the terms "uniformed flake" means "uniformly shaped, for example round, oval, corrugated, heart- or fish-shaped flakes or otherwise uniformly geometrically formed". This definition encompasses any geometrical shaped flake and it is not within the resources of the Office to prepare prior art products and compare the claims with such, and therefore, the burden is being shifted to applicant to show that the prior art flake did not have any geometrical shape.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Graham et al. (US Patent 3450540), Kruse (US Patent 2952540) or Ronai et al. (US Patent 4103034).

Graham et al. discloses a flaked feed at col. 6 which has a thickness of .005 to .02 inches thickness and 10-14% moisture content.

Kruse discloses a flaked product of .005-.006" or .01-.15" thickness. See col. 4, lines 49-52 and a moisture content of 18-20% (col. 3, line 65). See also example 1.

Ronai et al. disclose a flaked protein material which has a thickness .06-.001 inch (col. 7, line 47) and a moisture content of 12-25% (col. 8, lines 8-10). See claim 6.

"For aquatic animals" is use terminology and intended use of an otherwise old or obvious composition cannot render a claim patentable. In re Zierden, 162 USPQ 102, In re Jones, 50 USPQ 48, In re Spada, 15 USPQ 2d, 1655, In re Thuau 57 USPQ 324. The specification states that the terms "uniformed flake" means "uniformly shaped, for example round, oval, corrugated, heart- or fish-shaped flakes or otherwise uniformly geometrically formed". This definition encompasses any geometrical shaped flake and it is not within the resources of the Office to prepare prior art products and compare the claims with such, and therefore, the burden is being shifted to applicant to show that the prior art flake did not have any geometrical shape.

3. Claims 2-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Ronai et al. (US Patent 4103034).

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Claim 1, part (c) shows a size 1" to .04". Note col. 7, lines 9-10 which discloses colors and flavorants, which are inherently temperature-sensitive. "For aquatic animals" is use terminology and intended use of an otherwise old or obvious composition cannot render a claim patentable. In re Zierden, 162 USPQ 102, In re Jones, 50 USPQ 48, In re Spada, 15 USPQ 2d, 1655, In re Thuau 57 USPQ 324.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 768189 in view of EP 0337573.

The GB patent teaches a flaked feed for domestic animals, with a moisture content of 12-45% (page 2, col. 2, line 86), temperature sensitive materials at page 2, col. 1, line 15; col. 2, lines 124-126. The thickness is taught as 0.5 – 1.5 mm. The patent suggests the presence of sugars at page 2, line 52. Note that the patent teaches an embodiment wherein the flake is pressed after the addition of temperature sensitive materials, which are not destroyed. See page 3, col. 1, lines 5-10. The patent does not teach that the thickness is 10-350 μm .

EP' 573 also teaches flakes for pet foods, that contain sugars and are of a thickness of 0.2 -3 mm, which falls within the claimed range. See page 2, lines 29-30.

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Both compositions contain the same ingredients: carbohydrates, proteins, fats and temperature sensitive materials such as vitamins and/or sugar. Both compositions are for pets. Both compositions are for flaked feeds. It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the feed with either thickness, based on the similarity of the product as discussed above, and the same field of endeavor. The specification states that the terms "uniformed flake" means "uniformly shaped, for example round, oval, corrugated, heart- or fish-shaped flakes or otherwise uniformly geometrically formed". This definition encompasses any geometrical shaped flake and it is not within the resources of the Office to prepare prior art products and compare the claims with such, and therefore, the burden is being shifted to applicant to show that the prior art flake did not have any geometrical shape. The shape of the flaked feed would be considered as a matter of personal choice of the artisan since pets by themselves have no preference to shape and neither can they distinguish such features.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baensch (US Patent 3796812) and Bunch (US Patent 5618574) in view of Kim (US Patent 5773051).

Baensch teaches a fish-feed composition that includes yeast as one of its ingredients. Note that the feed is in the form of a sheet of "thin-walled thickness". Additionally, the reference teaches the flake thickness at col. 2, line 40, which thickness

size falls within the claimed range (0.1 to 1.0 mm). At col. 2, lines 15-20, patentee teaches that it is possible to break the sheets into smaller pieces prior to feeding.

The patent does not teach the moisture content or diameter size of the smaller pieces or the growth promoting ingredients.

Bunch enumerates the ingredients in a number of commercial fish feeds, including flaked feeds (col. 1, line 26), and that include vitamins,. See col. 3 that teaches conventional ingredients, which includes vitamins, yeast and bacteria. The patent also teaches growth promoting ingredients. See col. 4, lines 57-60. The patent states that the food is in the form of pellets or crumbles, "or other fish food forms". See col. 3, lines 8+, which also lists common ingredients in fish food.

Kim teaches fish feed, which contains glucose among other conventional ingredients for a fish feed, and which floats after sinking. The feed is flake-type (col. 2, line 34), has a water content of 15-25%, the diameter of the flake is 1-10 mm, which falls within the claimed range. Note the temperature-sensitive ingredients at Table I.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to break the sheets into pieces to a diameter taught by Kim and to incorporate the conventional ingredients along with yeast and bacteria, shown to be useful growth promoters.

The shape of the flaked feed is not taught by the prior art but this feature would be considered as a matter of personal choice of the artisan since fish by themselves have no preference to shape and neither can they distinguish such features. Also, Baensch teaches the various geometrical shapes of the sheet form at col. 1, lines 65-69

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and to break this down into pieces, as taught by the patentee, and to maintain these same shapes would have required no more than ordinary skill. As for claims 9-10, note that the patents are all drawn to fish feed and Bunch teaches that flaked feeds are conventional forms of fish feed in the art, and therefore, the methods of feeding aquatic animals is rendered obvious.

Response to Arguments

Applicant's arguments filed 3/13/2006 have been fully considered but they are not persuasive.

Based on the new grounds of rejection, the arguments presented by applicant are being addressed to the extent they are still applicable.

Applicant states that the GB patent is not drawn to fish feed. However, as stated in the rejection itself, "use" terminology in a composition claim does not lend patentability to an old composition. The EP patent is also faulted for the same reason, and therefore, this fact is also just as applicable here too. Further, applicant's characterization of the reference with respect to the thickness of the flake, as "slightly overlap at the higher range" does not traverse the rejection because such an overlap, slightly or not, is still an overlap. As for the water content, there is no requirement that in a rejection under 35 USC 103, all the limitations of a claim should be disclosed by a single reference. On the other hand note that when one reference drawn to fish feed shows a moisture content, then it is easily combinable with another reference also to

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fish feed, which states that the moisture content should be "suitable". To determine what is a "suitable moisture content", it would not be beyond the ambit of ordinary skill to look to another reference, drawn to a similar invention, for guidance.

The same reasoning holds good for the Kim reference, since applicant has stated that Kim is mainly concerned about fish food that initially sinks then refloats. This fact in no way hampers the reference from being consulted as to its flake diameter, moisture content being the same as that claimed. The Baensch and Bunch references are also criticized for not showing all the limitations. For instance, applicant states that the fish food of Baensch overlaps at the "high range of thickness" and it is made of sheet. The sentence: "However, the present invention is not limited to a specific configuration of the feed bodies, so that, if desired, also irregular shaped feed body sheets may be employed", does not take away from the feed body being "regular" shaped, since patentee states "so that, *if desired, also* irregular shaped feed body sheets may be employed" (emphasis added). Baensch's silence about the water content is not fatal, because this reference has been combined with others that do.

Applicant's traversal of Bunch that the reference only teaches flaked feeds in the Background section of the patent is not convincing because it has been well established that all of the disclosure must be considered not just the specific examples, *In re Uhlig*, 153 USPQ 460. The "non-preferred" as well as the "preferred portion" of a reference is pertinent for what it teaches to one skilled in the art. *In re Meinhardt*, 157 USPQ 270 (CCPA 1968). It follows therefore, that disclosure in any part of the patent, not just the

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claims, places the subject matter of the claims in the possession of the artisan having ordinary skill in the art.

Upon a review of applicant's arguments against the references individually, it must be noted that it is well established that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Unobviousness cannot be established by attacking references taken individually when rejection is based on a combination of references. *Ex parte Campbell* 172 USPQ 91 (BPA&I 1971). Finally, with regard to the separate patentability of claims 9-10, the novelty of these claims would be based on claim 1 being patentable. And since claim 1 is not patentable, then so too are claims 9-10.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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